

REMARKS

Claims 1-24 are pending in the Application. Claims 1-24 have been amended. No new matter has been added. Claim 1 is independent. Of note, independent Claim 1 has been amended to read more clearly, and does not include new matter.

On Page 2 of the Office Action, Applicant's election of Group I without traverse is acknowledged.

On page 2 of the Office Action, Claims 1-24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have made amendments herein that are believed to have overcome the rejection.

On page 3 of the Office Action, Claims 1, 10 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion, motivation or rationale either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Amended independent Claim 1 recites, in part, "a *flexible* housing *conformable* to a portion of a body," (emphasis added). Claim 1 further states, "a control circuit connected directly to two or more electrodes, wherein said control circuit and said electrodes are substantially contained *within* the housing," (emphasis added).

Primarily, page 3 of the Office Action states that Shiba discloses a flexible device at Column 4, Lines 36-40. The cited portion of the Shiba reference recites, “upper and lower portions 1 and 2 each comprise a compliant or flexible sheet of synthetic material 10, 20 which are adapted *for placement over an upper and a lower leg portion of a human body.*” As shown in FIG. 1, these flexible sheets are placed around the leg muscles, and clearly do not comprise a “housing” as stated in amended independent Claim 1. In addition, Shiba also discloses a “controller 42 electrically connected to the electrodes 40 and 41 *by way of an electric cord 43,*” (emphasis added). Both the “upper and lower portions 1 and 2” and the controller 42 are clearly illustrated in FIG. 1 of the Shiba reference as separate and distinct components with the cord connecting the two components. As such, even if the flexible sheets of the Shiba device could somehow be construed as a housing, the flexible sheets do not include “a control circuit connected directly to two or more electrodes” *within* the housing as stated in amended Claim 1. To the contrary, Shiba explicitly and unambiguously discloses a controller separated from the sheets and electrodes by a cord.

Nevertheless, with respect to the electrodes being located in the same housing as the control circuit, the Examiner asserts “it would have been obvious...to provide the electrodes located in the same housing, since it has been held that rearranging parts of an invention involves only routine skill in the art,” (Office Action, Page 4). The Examiner appears to take the position that it would have been obvious to integrate the controller into the flexible sheets disclosed by Shiba as surrounding the leg. But Shiba discloses a leg exercise apparatus, i.e., the device causes the contraction of leg muscles to extend and retract the leg (See Columns 5 and 6). Primarily, if the device causes the contraction of the leg muscles, the resulting movement of the leg would

significantly hamper the ability of someone using the device to manipulate a controller on a portion of the leg. Simply stated, if your leg is contracting back and forth while exercising with the Shiba device, it would be difficult if not impossible to access and/or manipulate a controller disposed on the moving leg, as the Examiner suggests. Moreover, as shown in FIGS. 6 and 7 of the Shiba reference, the device may be used with “only one leg of the user *lying with his or her face down*,” (Col. 6:56-60)(emphasis added). If Shiba was modified as the Examiner suggests, either the controller will be underneath the person (i.e., on the quadriceps) or the controller will be wholly inaccessible (i.e., on the hamstring). Either way, the device would not be operable as Shiba specifically describes. Proper patent examination requires that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In sum, not only would it *not* be obvious to modify Shiba as the Examiner suggests, Shiba teaches away from such a modification.

Applicants’ note that the Michelson reference was not cited as disclosing a flexible housing having the features stated in amended independent Claim 1, and Applicants’ agree that Michelson does not provide such disclosure. As such, the Shiba and Michelson references, whether considered alone or in combination with one another, fail to disclose each and every element of amended independent Claim 1 as required for a *prima facie* case of obviousness, and a withdrawal of the rejection is thus respectfully requested. In addition, Claims 10 and 11 are believed to be allowable as they depend from amended independent Claim 1.

On page 4 of the Office Action, Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Silverstone

(US 6,351,674). Claim 2 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

On page 5 of the Office Action, Claims 3, 4, 6 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Gilmer (US 4,014,323). Claims 3, 4, 6 and 8 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 5 of the Office Action, Claims 5, 7, and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Reiss (US 5,549,656). Claims 5, 7 and 9 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 6 of the Office Action, Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Beggs (US 6,917,293). Claim 12 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

On page 6 of the Office Action, Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Liss (US 5,851,223). Claim 13 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

On page 7 of the Office Action, Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Thomas (US 5,107,835). Claims 14 and 15 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 7 of the Office Action, Claims 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and DiLorenzo (US 2003/0018367). Claims 16 and 17 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 8 of the Office Action, Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Zilber (US 3,822,708). Claim 18 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not

disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

On page 9 of the Office Action, Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Yamazaki (US 2003/0153958). Claim 19 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

On page 9 of the Office Action, Claims 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Grey (US 5,397,338). Claims 20 and 21 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 10 of the Office Action, Claims 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Ceballos (US 6,522,915). Claims 22 and 23 depend either directly or indirectly from amended independent Claim 1, and recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable.

On page 10 of the Office Action, Claim 24 is rejected under 35 U.S.C. §103(a) as being unpatentable over Shiba (US 6,456,885) in view of Michelson (US 6,445,955) and Agarwal (US

2004/0116990). Claim 24 depends from amended independent Claim 1, and recites additional limitations which, in conformity with the features of its corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claim is therefore believed patentable.

For all of the above reasons, the claim objections are believed to have been overcome placing Claims 1-24 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No. 502104.

Respectfully submitted,

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